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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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LAWRENCEVILLE, GA 30044

EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/073,842	RODRIGUEZ ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	KIEU-OANH T. BUI	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 105, 106, 108-115 and 122-133 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 105, 106, 108-115 and 122-133 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Remark***

1. Claims 1-104 were canceled in the amendment no 12 (dated 5/24/04). Claims 107 and 116-121 were canceled, and claim 133 is previously added. Pending claims are claims 105-106, 108-115, and 122-133.

### ***Response to After Final Request for Reconsideration***

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 105-106, 108-115, and 122-133 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 105-106, 108-115, and 122-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al.(U.S. Patent No. 6,898,762 B2) in view of LaRocca et al.(US Patent No. 6,314,572 B1).

Regarding claim 105, this limitation is met as Ellis discloses a method implemented by a television set top box or set top terminal (STT) comprising the steps of outputting to a television screen by the STT configured to identify advertisement categories, and under a user input at the STT for identifying or selecting a category of advertisements at the STT, the corresponding advertisements are provided to the STT responsive to the user input (see Fig. 3 for the set top box 23; col. 14/lines 42-52 for the user preferences on the advertisement category can be either stored within the set top box or at the server 25, and based on the user input for advertisement contents, the advertisement contents corresponding to an interested category is displayed to the user, refer to Figs. 5-6 for advertisement categories as Sports, Children, Music, Events, Premium etc.). Ellis further discloses that advertisement category having a first advertisement category and a second advertisement category, and the user provides a first and a second input corresponding to the first category and the second category, and after receiving the first and second user inputs, outputting to the television screen by the STT the corresponding

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advertisements of the first and the second advertisement category at a first and second future time during an interruption in a television presentation being output by the STT (as shown in Fig. 9a as an example for a program will be displaying at certain times in the future using the start time and end time, even the segment of minutes can be selectable based on the user; and Fig. 21 at box 2070, Ellis clearly shows the target advertising is done based on preference user profile, refer to col. 20/line 63 to col. 21/line 39).

Ellis does not show the set top box includes a tuner therein; however, this is a must-have and known element within the set top box. In fact, LaRocca shows in a same interactive subscription on demand services to the user, the set top box includes a tuner for tuning and providing television program to viewers (LaRocca, col. 6/line 57 to col. 7/line 14 for a tuner). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis' system with LaRocca's known technique of further including a tuner within the set top box in order to provide the tuning to appropriate channel television programs and advertisement categories to the user based on the user's preference as taught by Ellis.

As for claim 106, this limitation is met as Ellis shows in Fig. 2c and 3 that the user uses a remote control 40 interacts with the set top box 28, which receives the video and data in 26 from a remote database, as shown in Fig. 2c with program guide server 25 at television distribution facility 16 (col. 5/line 24 to col. 6/line 50 for further details of interest).

(Claim 107 was canceled).

As for claim 108, this limitation is met as Ellis discloses that based on the scheduled time, the advertisement can only be targeted to right viewers based on their preferences and profiles from the set top or the user prior to receiving the user input (as shown in Fig. 9a as an example for a program will be displaying at certain times in the future using the start time and end time, even the segment of minutes can be selectable based on the user preset—defined prior to the user inputs; and Fig. 21 at box 2070, Ellis clearly shows the target advertising is done based on preference user profile, refer to col. 20/line 63 to col. 21/line 39).

As for claim 109, this limitation is met as Ellis discloses in Fig. 20b as the set top box offer a request whether the user selects the request or not as the third viewer input responsive to a request by the set top box.

As for claim 110, this limitation is met as Ellis discloses further comprising outputting the advertisement to a television during an interruption of the presentation of a television program having predetermined program categories (Fig. 22 as the user can define a preset additional information, i.e., software, internet links or videos, relate to the future broadcast programs based on his/her preferences).

As for claim 111, this limitation is met as Ellis further discloses that various attributes associated with groups of the advertisement categories as the subcategories of advertisements that correspond to respective broader categories (Fig. 21/at steps 2004, 2006, 2008).

As for claims 112 and 113, these limitations are met as Ellis further discloses that advertisements has defined duration display times, and they are stored within the set top terminal (Fig. 9A and col. 14/lines 47-51 for the preferences about advertisements can be stored in the client or user device).

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As for claims 114 and 115, these limitation are met as Ellis discloses that as soon as the user click through or viewed the advertisements, the advertisement can be removed based on the log of committed advertisements using the weight value as a measurement of user activities whether to select the advertisements for viewing or not (Fig. 24 for track viewing history, and the target advertising is based on viewing history, refer to col. 19/line 10 to col. 20/line 31 & col. 23/line 30 to col. 24/line 5).

As for claims 122-133, these claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 105-106, and 108-115 as disclosed in details above.

### ***Conclusion***

**6. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kieu-Oanh Bui', with a long horizontal flourish extending to the right.

Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2611

KB

Oct. 26, 2005